REMARKS

The present amendment is filed in response to the Office Action dated January 17, 2007, with a Request for Continued Examination. A previous amendment, filed after-final on May 15, 2007, was not entered, and Applicant instructs the Office that THE PREVIOUSLY FILED AFTER-FINAL AMENDMENT IS NOT TO BE ENTERED, as provided for in the MPEP at 706.07(h) D. The claims pending as of the Office Action of January 17, 2007, form the basis of the present amendment.

Claims 1, 3-35, and 45-52 will be pending upon entry of the present amendment. Claims 1 and 45 are amended and claims 2 is cancelled. No new matter has been added with the present amendment.

Applicant thanks the Examiner for indicating the allowability of claims 17-26 and the allowability of the subject matter of claims 2, 13-16, 31-34, 46, and 47. Accordingly, claim 1 has been amended to incorporate the subject matter of claim 2.

Rejections under 35 U.S.C. §§ 102, 103

Claims 1 and 3-7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Onion (U.S. 6,378,214), and claims 8-12, 27-30, 35, 45, and 48-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Onion in view of Polevoy et al (U.S. 6,685,379, hereafter *Polevoy*). For purposes of clarity, "Onion," as used hereafter is with reference to the Onion '214 patent. Reference to the specification of the present application will refer simply to "the specification."

Claim 1 has been amended to incorporate the subject matter of claim 2, indicated by the Examiner as having allowable subject matter. Applicant therefore understands claim 1 to be in condition for allowance, together with dependent claims 3-16.

Claim 27 recites, in part, "a blade … including a slot, the slot including a wide portion and a narrow portion." Onion and Polevoy fail to teach or suggest this limitation, either individually or in combination. The Office Action argues that, because Onion teaches that its collars may be formed integrally with the post, "it is inherently understood … that at least a portion of the slot would have to be larger than the size of the collars to fit the second locking

element in the blade." Applicant respectfully disagrees. The MPEP discusses an Examiner's burden with regard to a showing of inherency, as outlined in relevant part below.

> The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.... To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient....
>
> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

(MPEP § 2112 at IV; citations omitted, emphasis in the original.)

Applicant points to U.S. Patent 4,815,788 to May, which teaches a rivet 46 that slides along a slot 35 (see Figures 1 and 4 and column 4, lines 34-38). It can be seen that the heads of the rivet are wider than any portion of the slot. Another specific example may be found in the U.S. Patent 5,311,365 to Klearman et al. (see rivet 42 in slot 38, Figure 1 and column 3, lines 52-59). The formation of such rivets is well known in the art, and merely involves inserting the rivet into position and swaging an end until a desired clearance is achieved, which results in an integrally formed element similar to that described by Onion. Such loosely fitted rivets are common employed in sliding and pivoting joints that do not require disassembly, including, for example, slip-joint pliers and scissors. One of ordinary skill would recognize that a post with integrally formed collars can be manufactured through a process similar to that commonly employed to form rivets, as illustrated above. Accordingly, there is no inherent requirement that Onion's slot include a wide portion, as argued in the Office Action. Without such inherency, Polevoy has no relevance to Onion, inasmuch as it is directed to a system that is unrelated to the field of art of Onion, and there is absolutely no suggestion that its teachings might be adapted for use with Onion, or that such a combination would teach the limitations of claim 27.

The Office Action argues that providing a wider slot would permit easy and effective means for installing the locking element, "thereby eliminating the time consuming and costly manufacturing step of building the second locking element while attached to the blade."

With regard to motivation to modify a prior art reference, MPEP § 2143.01 I states that "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." Onion does not teach that it is directed to eliminating costly manufacturing steps, and is entirely silent with regard to such considerations. And there is nothing in the record that indicates that the knowledge of a person of ordinary skill in the art would lead one to Polevoy to find a teaching for reducing the cost of manufacture. Polevoy certainly does not teach or suggest that the locking mechanism of a folding knife might be less costly if manufactured according to its disclosure. Even if one were motivated to seek a more economical blade locking mechanism, there are dozens of blade-locking mechanisms in the art, many of which would probably be less costly to produce than Onion's, while there is nothing about Polevoy that offers a reasonable expectation of success. Clearly, there is no reasonable motivation to combine Polevoy with Onion.

Furthermore, Onion and Polevoy are from entirely different fields of art, and the functional differences between their systems are such that if Polevoy were combined with Onion, Onion would be rendered completely unsatisfactory for its intended purpose (see MPEP § 2143.01 ([i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification)).

First, Polevoy is directed to a system that includes a first element (structural member 10) in which a keyhole slot 14 is formed, and a second element (structural member 12) to which a standoff rivet 20 is *rigidly* and permanently attached (column 3, lines 12-21). In contrast, Onion includes a first element (blade 12) in which a slot 60 is formed and to which the post 30 is permanently and *slidably* attached. Onion's second element (handle 16) has neither a post nor a slot. Thus, while Polevoy has a rivet on a first element and a keyhole slot on a second element, Onion has a post and a slot on a first element only, with neither on a second element. Positioning either the post or the slot on its handle would render Onion's locking mechanism completely non-functional, and would also fail to teach the limitations of claim 27.

Second, Polevoy's keyhole slot 14 and standoff rivet 20 are arranged to couple its structural elements in a *separable* relationship, while Onion's post and slot do not couple the

blade to the handle, but only limit rotation of the blade. The blade and handle are *permanently* coupled by the pivot mechanism. Thus, there is no functional similarity or compatibility between Polevoy's rivet-and-keyhole system and Onion's slot-and-post system. If one were to logically combine Polevoy with Onion, the result might be a knife with a removable blade, or with a keyhole in the handle to hang the knife from a wall hook, neither of which bears any resemblance to the invention of claim 27.

Third, Polevoy provides a plug 24 that is inserted into the keyhole slot to prevent disengagement of its elements. The plug is shaped so that it "physically interferes with the movement of the standoff rivet 20, and thus prevents relative movement between the two structural members 10, 12, so that the structural member 12 having the standoff rivet 22 can not [*sic.*] move relative to the other structural member 10 …" (column 4, lines 15-20). To disengage the structural members, it is first necessary to remove the plug. On the other hand, disengagement of Onion's elements from a locked condition is prevented by the spring 62. If a plug as taught by Polevoy were combined with Onion's post and slot, it would interfere with proper operation of its locking mechanism. It would require that a user manually insert the plug into the slot after the blade was open, which would offer no advantage and would be awkward and possibly dangerous, and would also interfere with moving the blade to the closed position. Onion's post 30 and locking portion 16d are arranged so that a user can unlock the blade with one hand by sliding the post, as described at column 5, lines 1-6, with reference to Figure 5. This would be impossible if it was first necessary to remove a plug that "physically interferes with the movement," as taught by Polevoy.

Finally, even if Polevoy and Onion were analogous, and even if there were found a reasonable motivation to combine, no reasonable combination will teach and suggest all the limitations of claim 27. The Office Action indicates that Polevoy teaches that "it is well known to provide a slot … to aid in retaining a locking element having two integrally mounted collars …." This is absolutely incorrect. Polevoy has a standoff rivet that is any of a variety of projections that extend outwardly from one of the structural members having an outer, distal portion having larger dimensions …." (See column 1, lines 44-48.) Thus, Polevoy fails to teach or suggest "a locking element having two integrally mounted collars," as argued.

As demonstrated above, a combination of Polevoy with Onion, cannot produce an operational device. Only if one employs impermissible hindsight and uses the present application as a template, and infers elements not found in the references, can such a combination be produced. Accordingly, Polevoy and Onion do not teach or suggest the limitations of claim 27, which is therefore allowable.

Claim 28 recites "a retaining element configured to fit in the slot and prevent movement of the neck from the narrow portion of the slot to the wide portion of the slot." In rejecting original claim 27, the Examiner argues that it would have been obvious to modify Onion to "provide a slot having a first portion having a first width that was larger than the collars to allow a collar to pass through …." Then in rejecting claim 28, the Examiner points to Onion's attachment member 64 as corresponding to the retaining element of claim 28. However, applicant asserts that these positions are not compatible for the purpose of rejecting claim 28. As acknowledged by the Examiner, Onion's attachment member 64 is not removable from the blade (see page 4 of the Office Action, last paragraph). If the attachment member prevents movement of the neck to the wide portion of the slot, as would be necessary to support a rejection of claim 28, then it will also prevent the collar from passing through the wide portion of the slot, which was the motivation offered to modify Onion's slot in the obviousness rejection of claim 27. If the collar cannot pass through the wide portion, there is no motivation to provide the wide portion in the first place. If, on the other hand, the slot is provided with a wide portion that *does* allow a collar to pass through, it cannot also be provided with Onion's *non-removable* attachment member configured to prevent "movement of the neck from the narrow portion of the slot to the wide portion of the slot." Accordingly, claim 28 is allowable on its own merits.

Claim 45 recites, in part, "a slot formed in the blade and having first and second ends, the first end and a portion of the slot extending between the first and second ends having a first width, and the second end having a second width greater than the first width; [and] a retaining element removably positioned within the second end of the slot." As demonstrated above, there is no inherent requirement for a slot having a second width greater than the first width, and there is no reasonable rationale for combining Polevoy to provide such a teaching. Accordingly, claim 45 is allowable over the art of record.

In light of the above amendments and remarks, Applicant respectfully submits that all pending claims are allowable. While applicant has chosen not to argue the allowability of many of the dependent claims, this should not be construed as an admission that the dependent claims are not allowable on their own merits, apart from their allowability as depending from allowable base claims. Applicant, therefore, respectfully requests entry of the present amendment and timely allowance all pending claims. The Examiner is encouraged to contact Mr. Bennett by telephone at (206) 694-4848 to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Bennett by telephone to expeditiously correct such informalities.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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